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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
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09/239,873 01/29/99 LUHMAN

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EXAMINER

LEVY, N

ART UNIT

PAPER NUMBER

1616

DATE MAILED:

07/06/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

Applicant(s)

Examiner

Group Art Unit

8

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on 4/17/80
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 1-27 is/are pending in the application.
- Of the above claim(s) 5-7, 12, 15-20 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 1-4, 8-11, 13, & 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____.
 - ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 3-5
- ☐ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other _____

Office Action Summary

Art Unit: 1617

Receipt is acknowledged of amendment election of 4/17/00.

Applicant's election with traverse of Group I in Paper No. 7 is acknowledged. The traversal is on the ground(s) that Applicant argues in the Groups are not distinct and examiner is erroneous in characterizing the product as bait. This is not found persuasive because examiner finds the classification, products, and processes warrant separate consideration, and would result in separate, patentable, after multiple, burdensome search.

The requirement is still deemed proper and is therefore made FINAL.

As to the species requirement this also is maintained, because as claimed, infusion does not have to be as presented in applicants arguments it can be done via take through the esophageal groove.

Claims 5-7, 12, 15, ~~27, 34~~ and withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected Inventions and species, the requirement having been traversed in Paper No. 7.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

Art Unit: 1617

Claims 1-4, 8-11, 13 and 14 are rejected under 35 U.S.C. 102(b) as being anticipated by Merensalmi 4127678.

Sugar alcohols are supplied orally to milking cows, enhancing milk production (col. 1, lines 5-9) col. 2, line 14 - line 48) and is protected from breakdown in the rumen (col. 3, lines 30-33, to effectively increase blood sugar (Example 3).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 8-11, 13 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Merensalmi in view of Baalsrud et al. 3959493.

Merensalmi (above) provides sugar alcohols to the abomasum, effectively, protected while traversing the rumen, but, not in a typical rumen by pass format. But, it is also noted the alcohols replace glycerol, propionate and propionic acid (col. 1, bottom).

Baalsrud provides an example of Rumenal by pass, for delivery of propionic and (col. 3) to enhance milk production.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made desiring to utilize as by pass composition, to use one of Merensalmi, modified with Baalsrud to provide acceptable application.

Art Unit: 1617

Baalsrud teaches one having ordinary skill in the art would be motivated to perform this modification in order to increase amount of desired component to reach abomasum.

Claims 1-4, 8-11, 13 and 14 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-15 of copending Application No. 09/338314. Although the conflicting claims are not identical, they are not patentably distinct from each other because the 338 application encompasses the claimed subject matter.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper tames extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321© may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Neil Levy, whose telephone number is (703) 308-2412. The examiner can normally be reached on Tuesday-Friday from 7:00 a.m. to 5:30 p.m.

Art Unit: 1617

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jose Dees, can be reached on (703) 308-4628. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-1235.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1235.

N. Levy:jmr

June 20, 2000

A handwritten signature in black ink, appearing to read "Neil S. Levy", written in a cursive style.

NEIL S. LEVY
PRIMARY EXAMINER